

REMARKS

Status of the claims

Claims 1, 23-28, 30-48, 52-57 and 62-64 were pending and claims 25-28, 30-32, 36, 37, 39-41, 53-57 and 62-64 are under active examination. Claim 30 has been amended herein to for clarity. Support is found, for example, in Example 2, Table 1; Example 4 and Example 7. In addition, claims 56, 57, 62 and 63 have been cancelled, without prejudice or disclaimer. Thus, claims 1, 23-28, 30-48, 52-55 and 64 were pending and claims 25-28, 30-32, 36, 37, 39-41, 53-55 and 64 are under active examination

Applicants again note that upon indication that elected claim 30 is allowable, the withdrawn claims should be examined.

Claim Objections

Claim 56 was objected to for not reciting “residues” after cysteine in line 5. (Office Action, page 3).

Cancellation of claim 56, without prejudice or disclaimer, obviates the objection.

Double Patenting

Claims 25-28, 30-32, 36, 37, 39-41, 53-57 and 62-64 were provisionally rejected under the judicially-created doctrine of non-obviousness double patenting over claim 23 of copending application no. 12/001,939 in view of U.S. Patent No. 7,151,201. (Office Action, pages 3-7).

Applicants submit that the foregoing amendments obviate the rejection.

35 U.S.C. § 103

Claims 56 and 57

Claims 56 and 57 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 7,151,201 (hereinafter “Barbas ‘201”) or U.S. Patent No. 7,329,729 (hereinafter “Barbas ‘728”) in view of Filippova (1996) *Mol. Cell Biol.* 16(6):2802-2813 (hereinafter “Filippova”). (Office Action, page 8).

Cancellation of claims 56 and 57 obviates the rejections.

Claims 25-28, 30-32, 36, 39-41, 53-57 and 62-64

Previous claims 25-28, 30-32, 36, 39-41, 53-57 and 62-64 were rejected as allegedly obvious over Barbas '201 in view of Desjarlais et al. (1993) *Proc. Nat'l Acad. Sci. USA* 90:2256-2260 (hereinafter "Desjarlais"), Krizek et al. (1991) *J. Am. Chem. Soc.* 113:4518-4523 (hereinafter "Krizek") and Roehm et al. (1998) *J. Am. Chem. Soc.* 120:13083-13087 (hereinafter "Roehm"). (Office Action, pages 8-14).

In addition, these claims were also rejected as allegedly obvious over Barbas '728 in view of Desjarlais, Krizek and Roehm. (Office Action, pages 19-24).

Finally, these claims were rejected as allegedly obvious over Barbas '728, Krizek and Boulay et al. (1987) *Nature* 330:395-398 (hereinafter "Boulay"). (Office Action, pages 26-30). Barbas '728, Desjarlais and Krizek were cited as above and Boulay was cited for teaching a non-canonical *Drosophila* snail zinc finger. *Id.*

As acknowledged by the Examiner, Barbas '201, Barbas '728, Desjarlais, Krizek and Roehm teach zinc finger proteins having 3 or 4 particular amino acids between the C-terminal zinc coordinating residues. The pending claims specify that when this region contains 3 amino acids, the amino acids are SEN, IKG, IGG, SHT, KRL, or VRI, sequences not disclosed in this region in any of the references. Furthermore, with regard to Boulay, this reference teaches that X^L is consists of the amino acid sequence SSSN. The pending claims require that when X^L is four amino acids, X^L consists of the sequence SETG.

Thus, there is no combination of Barbas '201 or Barbas '728 with Desjarlais, Krizek and either Roehm or Boulay that teaches or suggests the claimed subject matter.

Claims 25-28, 30-32, 36, 37, 39-41, 53-57 and 62-64

Previous claims 25-28, 30-32, 36, 37, 39-41, 53-57 and 62-64 were also rejected as allegedly obvious over Barbas '201 in view of Desjarlais et al. (1993) *Proc. Nat'l Acad. Sci. USA* 90:2256-2260 (hereinafter "Desjarlais"), Krizek et al. (1991) *J. Am. Chem. Soc.* 113:4518-4523 (hereinafter "Krizek") and Boulay. (Office Action, pages 14-

18). Barbas '201, Desjarlais and Krizek were cited as above and Boulay was cited for teaching a non-canonical *Drosophila* snail zinc finger. *Id.*

For the reasons noted above, Barbas '201, Desjarlais, Krizek and Boulay fail, in combination, to teach or suggest zinc finger proteins as claimed. Thus, there is no combination of these references that teaches or suggests the claimed subject matter.

Claim 37

Claim 37 was rejected under 35 U.S.C. § 103(a) as allegedly obvious over Barbas '728 in view of Desjarlais, Krizek and Roehm, as cited above, and further in view of Guyer et al. (1998) *Genetics* 149:633-639 (hereinafter "Guyer"). (Office Action, pages 24-26).

In addition, claim 37 was rejected under 35 U.S.C. § 103(a) as allegedly obvious over Barbas '728 in view of Desjarlais, Krizek and Boulay, as cited above, and further in view of Guyer et al. (1998) *Genetics* 149:633-639 (hereinafter "Guyer"). (Office Action, pages 30-32).

For the reasons detailed above, there is no combination of Barbas '728, Desjarlais, Krizek and Roehm or Boulay that teaches or suggests the claimed subject matter. As Guyer fails to supply what is missing from the combination of primary references, the rejection cannot be sustained.

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CONCLUSION

In light of the amendments and remarks presented herein, it is believed that the elected subject matter is in condition for allowance. Applicants therefore request examination of generic subject matter. If the Examiner believes that a telephone conversation would expedite prosecution, she is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,

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